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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/020,240      | 12/18/2001  | Hiroshi Tanaka       | 0879-0366P          | 8756             |

2292 7590 06/20/2005

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EXAMINER

FOSTER, ROLAND G

ART UNIT PAPER NUMBER

2645

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/020,240 | <b>Applicant(s)</b><br>TANAKA ET AL. |  |
|                              | <b>Examiner</b><br>Roland G. Foster  | <b>Art Unit</b><br>2645              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.  
2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 14-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 10-13 is/are allowed.  
6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Priority***

The certified translation of the foreign priority papers were sufficient the date of the intervening reference U.S. Patent Application Publication No. 2003/0103144 A1 ("Sesek").

Thus, all rejections based on Sesek are withdrawn.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-9 and 14-25 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-7, 9, and 14-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,943,603 to Parulski et al. ("Parulski"), of record.

With respect to claim 1, Parulski discloses a communications terminal (combined cellular telephone/digital camera) (Fig. 7-9). The communications terminal comprises a receiving device (control processing unit 62) for receiving connection information (in the form of standard fax connection modes such as group VI fax) from a communication apparatus (destination fax

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machine) in order to properly transmit the stored image to the destination fax (col. 4, lines 50-67). Note that Group IV fax specifies a machine which operates at 64 Kps, which can only work on a digital channel, and which takes six seconds to transmit a 8 ½ x 11 page, and which supports certain progress codes. Thus, the Group IV connection mode strongly relates to connection information (e.g., digital, transmission speed, etc.). The connection information is received from (via) the cellular telephone (Fig. 7) part of the communication terminal. Thus, the connection information is for making a communication connection to the communication apparatus from a cellular phone. Parulski also discloses that the communication terminal comprises a transmitting and receiving device (cellular transceiver 66), which transmits and receives information to and from the communication apparatus (destination fax machine) based on the connection information received from (via) the cellular telephone receiver. For example, the transmitting and receiving device (transceiver 66) will have to support 64 Kps digital channel and certain fax progress codes (connection information). Thus, the information transmitted and received is based on the connection information.

Parulski discloses a combined cellular telephone/digital camera and thus fails to disclose that the communication terminal (digital camera) is separate from the cellular phone and locally positioned relative to the cellular phone when receiving the connection information.

However, in an alternative embodiment, Parulski discloses that the communication terminal (digital camera) is separate from RF receiver units A-B and locally positioned relative to the RF receiver units when receiving information (Fig. 1). Further, the RF link between the

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RF receiver units and the RF transmitter in the communication terminal (digital camera) may be part of a cellular system (col. 4, lines 10-28). Thus, Parulski teaches that the communication terminal (digital camera) is separate from a cellular device and locally positioned relative to the cellular device when receiving information.

To one of ordinary skill in the art at the time the invention was made, it would have been obvious to separate the communication terminal (digital camera) as taught by Parulski from the combined communication terminal/cellular telephone disclosed by Parulski.

The suggestion/motivation for doing so would have been to break an integrated device (e.g., the communication terminal (digital camera)/cellular device) into distributed devices in order to increase the flexibility of the device (e.g., the digital camera can be freed from the cellular telephone) and to reduce the cost to repair (e.g., the separate devices can be repaired/replaced individually). Further, modifying an integrated device to be separable would have been obvious according to legal precedent. MPEP § 2142.V.C. Finally, it would have been facially obvious to one of ordinary skill in the art, upon inspecting single patent containing two embodiments, to have desirable features from one embodiment into the other embodiment because both embodiments would have disclosed in the same document as one of ordinary skill inspected the document.

Claim 7 differs substantively from claim 1 in that claim 7 recites that the receiving device receives a "menu of destinations", which reads on camera display screen, which supports a menu

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of icons for the user to select, where the icons refer to destinations (Fig. 6 and col. 3, line 64 – col. 4, line 9). Claim 7 also recites an "input device", which reads on pen or stylus used to select the displayed icons.

With respect to claim 2, see Fig. 6, where the connection information as it relates to transmission data comprises which connected receiving device (destination fax machine) the picture will be transmitted to.

With respect to claims 4 and 9, the connection information includes attribute information such as a particular fax mode. Also, the connection information includes a particular dialed phone number (Fig. 10).

With respect to claim 5, the use designates (selects) a destination fax machine (communication apparatus) via an inputting device such as a "pen" (Fig. 6) or a keyboard (col. 5, lines 10-16) for the reception of picture data. The designation (selection) process includes discovering the capabilities of the designated communication apparatus (fax machine) based on connection information received from the fax machine via the cellular phone before any actual picture data is transmitted (col. 4, lines 44-67) (see also the claim 1 rejection). The camera (transmitting device) would then transmit and receive information to and from the designated communication apparatus (fax machine) based on the connection information previously received from the fax machine (via the cellular telephone) during the designation process. For

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example, Group IV fax includes progress codes (connection information) that are sent from the fax machine back to the transmitting device.

With respect to claims 6, 15, 18, 21, and 24, see Fig. 6. See the claim 2 rejection for further details.

With respect to claims 14, 17, 20, and 23, the communication terminal (camera) is at least partially digital.

With respect to claims 16, 19, 22, and 25, the mode switching element reads on the user selecting a destination fax machine, which switches the device into a communication mode all as discussed above. In addition, see col. 4, lines 44-50, where the "#" key is part of the separate communication termination/cellular phone combination as modified in the claim 1 rejection.

Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski as applied to claims 1 and 7 above.

Although Parulski discloses a digital camera (recording device), Parulski fails to disclose: 1) that the digital camera records a batch file in which a file name to be sent or received or, 2) that the content of a service is written in advance and that the transmitting and receiving device reads out the batch file and sends the file to the communication apparatus on the network.

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However, "Official Notice" was taken in the last Office action that both the concept and advantages of a digital camera that records a batch file where the file name or contents are written in advance, and where the file is read out and sent to a communication apparatus on the network, would have been well known in the art. Specifically, it is well known function of digital cameras to have a batch file creation function, where the file name is created in advance so that a batch of pictures may be stored and eventually sent to a communication device. The applicant's lack of traverse to the officially noticed fact in the last Office action is taken as an admission of the facts noticed.

To one of ordinary skill in the art at the time the invention was made, it would have been obvious to add this feature to Parulski.

The suggestion/motivation for doing so would have been to increase user-friendliness and versatility of digital camera, picture storage by allowing the user to specify a filename that the user can easily remember and then use this filename to store pictures, which are transferred to a remote device such as a computer where the file name allows for easy storage and retrieval. Such a process is notoriously well known in the art of digital cameras.

***Allowable Subject Matter***

Claims 10-13 are allowed.

***Examiner's Reasons for Allowance***

Independent claims 10 and 12 are detailed claims that recite significant structural detail sufficient to patentably distinguish over the prior art of record. For example, the subject claims recite the both the cellular phone and the communication terminal comprise a separate "receiving device" and a "transmitting and receiving device." Further, the cellular phone comprises an additional separate receiving device. Thus, a prior art arrangement where the cellular telephone comprised two "transmitting and receiving devices" (e.g., for each RF link) as is commonplace in the art would distinguish over the express language of the subject claims. Further regarding claim 10, the "transmitting and receiving device" in the cellular phone sends and receives information to a separate communication apparatus. However, the "transmitting and receiving device" in the communication terminal also sends and receives information to the communication apparatus. Thus, a prior art arrangement where only one link was used to send connection information to the communication apparatus would distinguish over the express language of the subject claim 10. Further regarding claim 12, the transmitting and receiving device in the cellular phone is limited to a "dial-up connection" to the communication apparatus. Thus, a prior art arrangement that efficiently used a non-dialup connection (e.g., non-voice data signaling) would distinguish over the express language of the subject claim 12.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland G. Foster whose telephone number is (571) 272-7538. The examiner can normally be reached on Mon to Fri from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roland G. Foster  
Primary Patent Examiner  
June 13, 2005